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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,017

Applicant(s)

DURBIN ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Status of Claims***

1. In view of the Appeal Brief filed on 07 April 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-26 have been examined.

***Claim Objections***

3. Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 18 is dedicated to a computer program, however claim 22 does not further limit claim 18 as it is directed to the medium where the program is stored.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 18-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 is non-statutory as it recites non-functional data. Specifically, the claim is non-statutory because it is directed to a computer program not stored on a computer readable medium. Similarly, claim 23 is non-statutory because a carrier wave is not a computer readable medium as it is not persistent storage.

Claims 19-22 and 24-26 are also rejected as they depend from claims 18 and 23 respectively.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claims 7, 12-14, 16, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 7 and 26 recite "remotely enabling the feature automatically", however this limitation is not supported by the Specification. The Applicant only provides for sending an enabling feature from a remote location and enabling an option using said feature (Specification, page 8, paragraph 23, page 9, paragraph 25, page 10, paragraphs 25 and 26, page 11, paragraph 28).

Claim 12 recites the system generating an option key specific to a system ID. The Specification, however, only discloses using a system ID to verify whether a feature is enabled (page 8, paragraph 24).

Claims 13, 14, 16 and 17 are also rejected as they depend from claim 12.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 11-14 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites conditional language without sufficiently providing one of ordinary skill instructions for proceeding in the event at least one of the

conditions fails (see claim 18 and its use of "otherwise"). Therefore, claims 11-14, 16 and 17, have been examined as if the user ID has not been validated, hence claims 12-14, 16 and 17 do not occur.

Claims 12-14, 16 and 17 are also rejected as they depend from claim 11.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 6, 7, 23, 24 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Neville et al., U.S. Patent No. 6,272,636.

As per claims 1-3, 23, and 24, Neville et al. teach a system for remotely enabling software comprising: receiving a user ID at a centralized facility from a user, an option-enabling request from the user specifying an option requested to be enabled in equipment at a subscriber station, electronically sending an enabling feature (e.g. electronic confirmation) from the centralized facility to the

equipment in the subscribing station and activating the option in the equipment (column/line 13/13-14/15). Neville et al. also teach a software key to enable software previously installed equipment (column/line 13/13-14/15). The step of confirming that an option has not already been enabled is inherent in the teachings of Neville et al. because by contacting the server/clearinghouse, the user is informing the server/clearinghouse that the feature has not been enabled.

As per claims 6, 7 and 26, Neville et al. teach authenticating a user ID and downloading the enabling feature automatically and without further user input (column/line 13/13-14/15).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4, 5, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636.

As per claims 4, 5, 15, and 25, Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a

medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Regarding claims 5 and 25, Neville et al. specifically recite "try before you buy", and "crippled" software distribution models (column 2, lines 11-47), therefore, it would have been obvious to one of ordinary skill to use the secure product execution method of Neville et al. to activate trial options or features (column/line 13/13-14/15).

14. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Linden et al., U.S. Patent No. 6,360,254.

As per claims 8 and 9, Neville et al. teach a system for enabling software options in a computer (abstract). However, Neville et al. do not specifically recite sending enabling features by e-mail and electronic confirmation of the option enablement. Linden et al. teach a secure method for enabling a remote computer to access a resource comprising sending an enabling feature by e-mail and sending a verification e-mail to the user confirming option enablement (column 11, lines 28-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Linden et al. as Neville et al. generally recite a server computer enabling a software feature



running on a remote client system via telecommunication means and services ('636, column 10, lines 62-65). Hence as electronic mail is such a means and service it would have been obvious to use the e-mail teaching of Linden et al. ('254, column 11, lines 28-39).

15. Claims 10-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Elteto et al., U.S. Patent No. 5,737,424.

As per claims 10-14, 16-18, Neville et al. teach validating an options request, creating an option key in response thereto, a communications network for relaying data, and transmitting the option key through an external communications network (figures 8 and 9; column 10, lines 62-65; column/line 13/13-14/15). Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Neville et al. also teach receiving and validating a user ID/system ID, receiving an option request from a user and invalidating a user ID/system ID (column 13, lines 20-35), comparing the request against other requests (column 13, lines 20-25 and 60-67) and "try

before you buy” and “crippled” software distribution models (column 2, lines 11-47). Regarding “trial software”, Neville et al. recite evaluation periods based on a number of executions or time periods (column 13, lines 60-67) and tracking the number of user requests for a digital product (column 13, lines 20-25). However, Neville et al. do not specifically recite generating an option key in response to a user request. Elteto et al. teach a method and system for securely distributing software comprising the generation of an option key in response to a user request (column 1, lines 48-60). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Elteto et al. in order to prevent the uncontrolled distribution of software.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Oki et al., U.S. Patent No. 6,115,471 as applied to claim 18 and in further view of Ernest, U.S. Patent No. 4,888,798.

As per claim 19, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Neville et al. also disclose “try before you buy” and

“crippled” software distribution models (column 2, lines 11-47). Elteto et al. teach generating keys after receiving a user request (column 1, lines 49-61). However, neither Neville et al. nor Elteto et al. specifically recite a software key with a disablement feature. Earnest teaches a system for securing distributed software using software keys, with a predetermined time based disablement option, to unlock specific features (column/line 14/66-15/30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Elteto et al., and Ernest in order more securely control trial period software.

17. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Elteto et al., U.S. Patent No. 5,737,424 as applied to claim 18 above, and in further view of Oki et al., U.S. Patent No. 6,115,471.

As per claims 20-22, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Elteto et al. teach generating keys after receiving a user request (column 1, lines 49-61). However, neither Neville et al.

nor Elteto et al. specifically recite authenticating a user ID prior to receiving a request and system ID. Oki et al. teach a software distribution system comprising authenticating a user ID, prior to receiving an option enabling request and receiving then authenticating a system ID (column/line 7/55-8/11). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Elteto et al., and Oki et al. in order to prevent illegal copying of software ('471, column 8, lines 1-5).

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

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(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

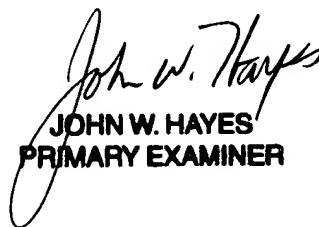
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

June 3, 2004

  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**